

REMARKS

The present application was filed on December 4, 2000 with claims 1-20. Claims 7, 8, 13, 19 and 20 have been canceled. Claims 1-6, 9-12 and 14-18 are pending, and claims 1, 11 and 14 are the pending independent claims.

In the outstanding Office Action dated June 16, 2005, the Examiner: (i) objected to claims 8, 13 and 20; (ii) rejected claims 1-20 under 35 U.S.C. § 112, second paragraph; (iii) rejected claims 1, 2, 6-14 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,473,778 to Gibbon (hereinafter "Gibbon") in view of U.S. Patent No. 6,077,311 to Lichtenstein et al. (hereinafter "Lichtenstein") and U.S. Patent Application Publication No. 2001/0004258 to Yokouchi (hereinafter "Yokouchi"); and (iv) rejected claims 3-5 and 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Gibbon in view of Lichtenstein and U.S. Patent No. 6,654,030 to Hui (hereinafter "Hui").

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following remarks.

Regarding the objection to the claims dependent claims 7, 8, 13, 19 and 20 have been canceled.

Regarding the rejection of claims 1-20 under 35 U.S.C. § 112, second paragraph, independent claims 1, 11 and 14 have been amended to recite a "single multimedia repository file." Independent claims 1, 11 and 14 have also been amended to recite "for creation" for purposes of clarity.

Regarding the rejection of claims 1, 2, 6-14 and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Gibbon in view of Lichtenstein and Yokouchi, Applicants respectfully assert that the cited combination fails to establish a prima facie case of obviousness under 35 U.S.C. § 103(a), as specified in M.P.E.P. § 2143.

As set forth therein, M.P.E.P. § 2143 states that three requirements must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited combination must teach or suggest all the claim limitations. While it is sufficient to show that a

prima facie case of obviousness has not been established by showing that one of the requirements has not been met, Applicants respectfully believe that none of the requirements have been met.

First, Applicants assert that no motivation or suggestion exists to combine Gibbon, Lichtenstein and Yokouchi in a manner proposed by the Examiner, or to modify their teachings to meet the claim limitations. For at least this reason, a prima facie case of obviousness has not been established.

The Federal Circuit has stated that when patentability turns on the question of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual question of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id at 1343-1344.

In the Office Action, on page 5 paragraph 4, and page 7, paragraphs 2-3, the Examiner provides the following statements to prove motivation to combine Gibbon and Lichtenstein and Gibbon and Yokouchi, respectively, with emphasis supplied:

“it would have been obvious . . . to have combined Lichtenstein into Gibbon for showing that the process of creating a multimedia repository file executable on a multimedia player in Gibbon is a batch-mode process since said process is programmed and performed without human intervention”

“It would have been obvious . . . to have combined Yokouchi into Gibbon since the modifying feature in Yokouchi provides the advantage to incorporate into Gibbon for offering users various ways to present a template as desired by modifying the description file in the template for modifying the template.”

The Examiner provides two additional statements of obvious in the Office Action on page 7, paragraphs 3 and 4. However, the Examiner provides no support for the contentions described in these paragraphs. Therefore Applicants request that the Examiner cite prior art or submit an Examiner’s affidavit to establish a basis for these assertions.

Applicants submit that the statements above are based on the type of “subjective belief and unknown authority” that the Federal Circuit has indicated provides insufficient support for an obviousness rejection. More specifically, the Examiner fails to identify any objective evidence of record which supports the proposed combination.

It is well-settled law that “teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis in original). Moreover, in order to avoid the improper use of a hindsight-based obviousness analysis, particular findings must be made as to why one skilled in the relevant art, having no knowledge of the claimed invention, would have selected the components disclosed by Gibbon, Lichtenstein and Yokouchi in the manner claimed (*See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)). The Examiner’s conclusory statements do not adequately address the issue of motivation to combine references. “It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to ‘[use] that which the inventor taught against its teacher.’” *In re Sang-Su Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002) (quoting *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983)).

Secondly, Applicants assert that there is no reasonable expectation of success in achieving the present invention through a combination of Gibbon, Lichtenstein and Yokouchi. For at least this reason, a prima facie case of obviousness has not been established. Applicants do not believe that Gibbon, Lichtenstein and Yokouchi are combinable since it is not clear how one would combine them. No guidance was provided in the Office Action as to how the three references can be combined to achieve the present invention. However, even if combined, for the sake of argument, they would not achieve the techniques of the claimed invention.

Lastly, the collective teaching of Gibbon, Lichtenstein and Yokouchi fails to suggest or render obvious at least the elements of independent claims 1, 11 and 14 of the present invention. For at least this reason, a prima facie case of obviousness has not been established.

Independent claim 1 recites a method of multi-stage creation of multimedia content. Multimedia assets are incorporated into a framework as a series of related frames comprising a

header frame, a thumbnail frame, a meta frame, one or more media frames and an end of sequence frame. A multimedia description file is created in a template for formatting multimedia assets. The multimedia assets and the multimedia description file are combined in the template through a batch-processing program to create a multimedia repository file executable on a multimedia player. The multimedia description file and the multimedia repository file are stored as a single multimedia repository file on a storage device. The single multimedia repository file is accessed by at least one authoring session manager for access to the multimedia assets, for creation of a modified multimedia description file in a template, and for creation of a modified multimedia repository file upon combination of the multimedia assets and the modified multimedia description file. For each authoring session manager, the modified multimedia description file and the modified multimedia repository file are stored as a single modified multimedia repository file on a storage device associated with the authoring session manager, wherein the modified multimedia repository file is configured for execution on a multimedia player. Independent claims 11 and 14 recite similar limitations.

The examiner contends that Gibbon discloses the incorporation of multimedia assets into a framework as a series of related frames. However, Gibbon only discloses the extraction of video frames as digital images, and fails to disclose a series of related frames comprising a header frame, a thumbnail frame, a meta frame, one or more media frames and an end of sequence frame, as recited in the independent claims of the present invention. Support for the amendment to this element of the independent claims can be found in FIG. 2 and pages 6-7 of the specification.

The Examiner further contends that Gibbon discloses the combining of multimedia assets and a multimedia description file to create a multimedia repository file executable on a multimedia player. However, Gibbon only discloses the application of a template set to multimedia descriptors resulting in an HTML representation. An HTML representation differs significantly from a multimedia repository file executable on a multimedia player. Thus, Gibbon fails to disclose the combining of multimedia assets and a multimedia description file to create of a multimedia repository file that is executable on a multimedia player, as recited in the independent claims of the present invention.

Additionally, the Examiner contends that Gibbon discloses the storing of a multimedia description file and a multimedia repository file, which is a combination of the multimedia assets and the multimedia description file, as a single multimedia repository file on storage device. However, as admitted by the Examiner, Gibbon only discloses the existence of an HTML file, which is a combination of multimedia descriptors and a template. Thus, even assuming *arguendo*, that the multimedia repository file does not differ significantly from the HTML file, Gibbon does not disclose that the HTML file is stored with the multimedia descriptors as a single file. Therefore, Gibbon fails to disclose the storing of a multimedia description file and a multimedia repository file as a single multimedia repository file, as recited in the independent claims of the present invention.

As admitted by the Examiner, Gibbon fails to disclose the accessing of the single multimedia repository file for creation of a modified multimedia description file in a template, and the accessing of the single multimedia repository file for the creation of a modified multimedia repository file upon combination of the multimedia assets and the modified multimedia description file. The Examiner contends that Yokouchi discloses these elements. However, the portions of Yokouchi relied upon by the Examiner simply disclose a template with an editing description relating to images. Therefore, the combination of Gibbon and Yokouchi fails to disclose the creation of a modified multimedia description file and the creation of a modified multimedia repository file through the accessing of the multimedia repository file, as recited in the independent claims of the present invention.

The Examiner further admits that Gibbon fails to disclose the storing of the modified multimedia description file and the modified multimedia repository file as a single modified multimedia repository file on a storage device associated with an authoring session manager. The Examiner fails to point to a portion of Gibbon, Lichtenstein or Yokouchi that discloses anything remotely close to this element of the independent claims. Therefore, Applicants assert that the combination of Gibbon, Lichtenstein and Yokouchi fails to disclose the storing of a modified multimedia description file and a modified multimedia repository file as a single modified multimedia repository file on a storage device associated with an authoring session manager, as recited in the independent claims of the present invention.

Dependent claims 2, 6, 9, 10, 12 and 18 are patentable at least by virtue of their dependency from independent claims 1, 11 and 14, and also recite patentable subject matter in their own right.

Claims 7, 8, 13, 19 and 20 have been canceled. Accordingly, withdrawal of the §103(a) rejection of claims 1, 2, 6-14 and 18-20 is respectfully requested.

Regarding the rejection of claims 3-5 and 15-17 under 35 U.S.C. §103(a) as being unpatentable over Gibbon in view of Lichtenstein and Hui, Applicants assert that dependent claims 3-5 and 15-17 are patentable at least by virtue of their dependency from independent claims 1 and 14. Further, one or more of dependent claims 3-5 and 15-17 recite patentable subject matter in their own right. Accordingly, withdrawal of the §103(a) rejection of claims 3-5 and 15-17 is respectfully requested.

In view of the above, Applicants believe that claims 1-6, 9-12 and 14-18 are in condition for allowance, and respectfully request withdrawal of the §112, second paragraph, and §103(a) rejections.

Respectfully submitted,



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